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APPLICATION NO.	F	TLING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,012	10/823,012 04/13/2004		Micheal Patrick Dillon	R0130D-CON	4690
24372	7590	04/20/2005		EXAMINER	
ROCHE PALO ALTO LLC			STOCKTON, LAURA		
PATENT LAW DEPT. M/S A2-250 3431 HILLVIEW AVENUE			ART UNIT	PAPER NUMBER	
PALO ALT	PALO ALTO, CA 94304			1626	
				DATE MAILED: 04/20/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary    Examiner   Laura L Stockton, Ph.D.   1628		Application No.	Applicant(s)				
Latura L. Slockton, Ph.D.    Latura L. Slockton, Ph.D.   1526		10/823,012	DILLON ET AL.				
Period for Reply  A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  - Extentions to the major by available used the precision of 3 CFR 1.158(a). In a event, harvever, may a reply be timely filed  - If the period for reply a specified above is the stem biliny (30) days, a reply with the statutory military on the high office of the provision of the reply is specified above. The maximum statutory period will agrie with will reply and will applie to design she period of this communication of the young of the period for reply a specified above. The maximum statutory period will apply and will applie 180 (MMN) his from the mailing date of this communication of the young of the period of the statutory period will apply and will apply and will apply the considered this, Avy reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any search of the period of the statutor of the period of this communication, even if timely filed, may reduce any search of the period of this communication, even if timely filed, may reduce any search of the mailing date of this communication, even if timely filed, may reduce any search of the mailing date of this communication, even if timely filed, may reduce any search of the mailing date of this communication, even if timely filed, may reduce any search of the mailing date of this communication.  1) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Expanded Technology 1, 1935 C.D. 11, 453 O.G. 213.  Disposition of Claims  4) Claim(s) 48-62 is/are pending in the application.  4) Of the above claim(s) 53 and 55-62 is/are withdrawn from consideration.  5) Claim(s) 48-62 is/are allowed.  6) Claim(s) 48-62 is/are allowed.  6) Claim(s) 48-62 is/are allowed.  6) Claim(s) 48-62 and 54 is/are rejected.  7) Claim(s) 48-62 and 54 is/are rejected.  7) The dr	Office Action Summary	Examiner	Art Unit				
Period for Reply  A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  - the period for reply specified some the mailing date of this communication. Silo(a). In an event, however, may a reply be timely filed after Ski (8) MONTHS from the mailing date of this communication. Silo(a) and event, however, may a reply be timely filed after Ski (8) MONTHS from the mailing date of this communication. It is period for reply begind above, the maintening replication is reply and will expire Ski (8) MONTHS from the mailing date of the scanning and large ski (8) MONTHS from the mainting date of this communication. Provided the scanning plant term adjustment. See 37 CFR 1704(b).  Status  1) Responsive to communication(s) filled on December 16, 2004 and February 14, 2005. 2a) This action is FINAL. 2b) This action is non-final.  3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.  Disposition of Claims  4) Claim(s) 48-62 is/are pending in the application.  4a) Of the above claim(s) 53 and 55-62 is/are withdrawn from consideration.  5) Claim(s) 48-62 is/are allowed.  Paper Nelo(s) filed on is/are: allowed and replication requirement.  Applicant may not request that any objection to the drawing(s) be held in aboyance. See 37 CFR 1.85(a).  Replacement drawing sheet(s) inducing the correction is required if the drawing(s) is objected to See 37 CFR 1.121(d).  11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.  Priority under 35 U.S.C. § 119  12) Acknow		Laura L. Stockton, Ph.D.	1626				
THE MAILING DATE OF THIS COMMUNICATION.  Elements of time may be suitable under the provisions of 3°C PR. 136(a). In no event, however, may a roply be timely filed after SK (it) NONTR's form the mailing date of this communication.  **No period or large his specified to the provisions of 3°C PR. 136(a). In no event, however, may a roply be timely filed after SK (it) NONTR's form the mailing date of this communication.  **No period for reply is specified betwer, the maximum statistury priod with the pays and village pays and village pays.  **Foliars to reply within the set or observide priority for pays and the pays and village pays and village pays.  **Foliars to reply within the set or observide pays and village pays and village pays.  **Foliars to reply within the pays and the pays and the pays and village pays and village pays.  **Foliars to reply within the set of restriction of pays and pays and pays and pays the pays and pays an							
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Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.  Priority under 35 U.S.C. § 119  12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) All b) Some c) None of:  1. Certified copies of the priority documents have been received.  2. Certified copies of the priority documents have been received in Application No.  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.  Attachment(s)  1) Notice of References Cited (PTO-892)  2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  Paper No(s)/Mail Date 4/13/04.  5) Notice of Informal Patent Application (PTO-152)  Notice of Informal Patent Application (PTO-152)	Applicant may not request that any objection to the	drawing(s) be held in abeyance. See	e 37 CFR 1.85(a).				
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#### DETAILED ACTION

Claims 48-62 are pending in the application.

#### Election/Restrictions

Applicants' election without traverse of Group I, and the species of Example 3 in step 4 on page 49 (reproduced below) in the reply filed on December 16, 2004 is acknowledged.

The requirement is still deemed proper and is therefore made FINAL.

Claims 53 and 55-62 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions. Election was made without traverse in the reply filed on

December 16, 2004.

#### Information Disclosure Statement

The Information Disclosure Statement filed on April 13, 2004 has been considered by the Examiner.

#### Claim Objections

Claim 54 is objected to because of the following informalities: at the end of line 2 of claim 54, "an" should be changed to "and". Appropriate correction is required.

#### Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 48-52 and 54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 8, 10, 12-14, 18, 20, 27-30, 32, 44-47, 56-58, 60 and 64 of U.S. Patent No. 5,952,362 (Cournoyer et al.) and claims 1-10, 17 and 26-39 of U.S. Patent No. 6,756,395 (Dillon et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claimed compounds are generically described in the claims of U.S. Patent No.

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6,756,395 and are positional isomers of the compounds claimed in U.S. Patent No. 5,952,362.

In U.S. Patent No. 6,756,395, see claim 1 (column 62) and especially the first compound listed in claim 38 (column 65) of this patent which is the same as the first compound listed in instant claim 52.

In U.S. Patent No. 5,952,362, see claim 1 (columns 124-125) and especially claim 27 (column 127) and claim 44 (column 128). The sulfonamide group in the compounds found in U.S. Patent No. 5,952,362 is attached to the phenyl ring meta to the imidazolin-2-yl-methyl group instead of para to the imidazolin-2-yl-methyl group as instantly claimed (i.e., a positional isomer). Nothing unobvious is seen in substituting the known claimed isomer for the structurally similar isomer, as claimed in U.S. Patent No. 5,952,362 since such structurally related compounds suggest one another and would be expected to share common properties absent

a showing of unexpected results. <u>In re Norris</u>, 84 USPQ 458 (1950).

One skilled in the art would thus be motivated to prepare compounds embraced by the claims of U.S. Patent No. 6,756,395, or alternatively, prepare positional isomers of the compounds claimed in U.S. Patent No. 5,952,362, to arrive at the instant claimed compounds with the expectation of obtaining additional beneficial products which would be useful in treating, for example, urinary incontinence. The instant claimed invention would have been suggested and therefore, obvious to one skilled in the art.

### Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought

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to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 48-52 and 54 are rejected under 35 U.S.C. 103(a) as being obvious over Cournoyer et al. {U.S. Pat. 5,952,362} for reasons set forth below.

The applied reference has a common inventor (i.e., Counde O'Yang) with the instant application. upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or

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declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(1)(1) and § 706.02(1)(2).

Claims 48-52 and 54 are rejected under 35
U.S.C. 103(a) as being unpatentable over Cournoyer et
al. {U.S. Pat. 5,952,362}.

Determination of the scope and content of the prior art (MPEP \$2141.01)

Applicants claim imidazolin-2-yl-methylphenyl compounds. Cournoyer et al. teach imidazolin-2-yl-methylphenyl compounds that are structurally similar to the instant claimed compounds. See in Cournoyer et

al., for example, formula 1 in columns 7 and 8 and especially the sixth compound listed in the table in column 39.

# Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the compounds of Cournoyer et al. and the compounds instantly claimed is that the sulfonamide group is attached to the phenyl ring meta to the imidazolin-2-yl-methyl group instead of para to the imidazolin-2-yl-methyl group as instantly claimed (i.e., a positional isomer).

# Finding of prima facie obviousness--rational and motivation (MPEP \$2142-2413)

Nothing unobvious is seen in substituting the known claimed isomer for the structurally similar isomer, as taught by Cournoyer et al., since such structurally related compounds suggest one another and would be

expected to share common properties absent a showing of unexpected results. *In re Norris*, 84 USPQ 458 (1950).

One skilled in the art would thus be motivated to prepare positional isomers of the compounds taught by Cournoyer et al. to arrive at the instant claimed compounds with the expectation of obtaining additional beneficial products which would be useful in treating, for example, urinary incontinence. The instant claimed invention would have been suggested and therefore, obvious to one skilled in the art. A strong case of prima facie obviousness has been established.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either

Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620 Technology Center 1600

April 14, 2005

JOSEPH K. MCKANE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600